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EXAMINER

AUCHTER, BENJAMIN D

ART UNIT

PAPER NUMBER

2644

DATE MAILED: 09/29/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/804,011

Applicant(s)

NAYHOUSE ET AL.

Examiner

Benjamin D Auchter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☒ Claim(s) 11 and 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/26/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because of a grammatical error on Line 10. The sentence containing "...implements a safety feature overrides the..." should be rewritten to "for overriding," "which overrides" or the like. Correction is required. See MPEP § 608.01(b).
2. The disclosure is objected to because of the following informalities: In the brief description of the drawing (Page 6, Line 15) there is a reference "telephone 100a" to figure 2. There is no pointer 100a in figure 2. On Page 8, line 12, the label 110 in fig. 1 is referred to as having digits "7-8-1", while 110 contains the digits "01181." On page 10, line 2, the label 102 in fig. 2 is referred to but does not exist. On page 14, line 6, the label 203 in fig. 4 is referred to but does not exist. On page 15, line 15, the beginning of the paragraph "If the result of step 202 is a no..." is contrary to the information in figure 4. It is suggested that the "no" be changed to "a match." On page 16, line 1, the beginning of the paragraph "If the result of step 202 is a yes..." is contrary to the information in figure 4. It is suggested that the "yes" be changed to "not a match."

Appropriate correction is required.

Claim Objections

3. Claim 11 is objected to because of the following informalities: Lines 7-8 of the claim recites **retrieve from said storage signals representing programmed digits** (page 19, line 7)

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which appears to be referring to retrieving signals representing programmed digits from the storage memory. It is suggested the phrase be rewritten as “retrieve, from said memory, signals representing programmed digits.” Appropriate correction is required. For the remainder of this Office action, examiner assumes the wording as suggested.

4. Applicant is advised that should claim 15 be found allowable, claim 16 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 14 and 18 are rejected under 35 U.S.C. 101 for the reasons cited in paragraphs 8-10 in this Office action.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. Claims 14 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 14 claims the method of claim 13 with a telephone apparatus. A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph.

9. Claim 18 encompasses all of the method of claim 13 **wherein said electrical signals corresponding to digits are generated by the telephone of claim 1**. This creates a dependency on both a method and an apparatus and thus is indefinite under 35 U.S.C. 112, second paragraph.

10. Claims 14 and 18 are also rejected under 35 U.S.C. 101 because each claim is directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1-3, 5-7, 11-12, 15-17, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Waldman (US Patent 5,157,719).

13. Regarding Claim 1, Waldman discloses an **input device for entering keyed in digits corresponding to local digits of a telephone number** (Figure 1, Reference 10). Waldman discloses a “automatic dial out of any given programmed digits” corresponding to area code digits (Column 17, Lines 60-61) corresponding to an **area code selection device for selection of programmed digits corresponding to an area code of said telephone number**. Waldman discloses **memory storage for said programmed digits** (Figure 1A, Reference 15; Col 6, Lines 10-16). Waldman further describes a **processor programmed to retrieve said storage and combine said programmed digits with said keyed in digits and transmit a signal corresponding to a combined telephone number that includes said keyed in digits and said programmed digits** as described in Column 5, Lines 51-57; Column 8, Line 65 through Column 9, Line 3 and diagrammed in Figure 2, references 22, 15, 18, 19.

14. Regarding Claim 2, Waldman discloses a detection and decision process whereby if the user presses 1 or any number of keys not equal to 7 or 11 presses (i.e. **a processor programmed to compare said keypad digits with a set of special number sequences**) the result is a transmission of **telephone signal codes that are based on the result of said comparison** (Col. 7, Lines 50-63).

15. Regarding Claim 3, Waldman discloses a **keypad as a real-time input device** (Figure 2, reference 10-2).

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16. Regarding Claim 5, Waldman provides an alternative embodiment wherein a “Voice Recognition dialing” performs the function as a **real-time input device** (Column 18, Lines 45-50, 64-66).

17. Regarding Claim 6, Waldman discloses an embodiment that includes the use of **nonvolatile electrical memory** (i.e. “ROM” Column 17, Line 46) **for storage of special number sequences** (i.e. “other area codes” Column 17, Lines 43-47).

18. Regarding Claim 7, Waldman discloses a telephone as in Claim 1 **further comprising a display** (Figure 1, reference 16).

19. Regarding Claim 11, Waldman discloses **a real-time input device for entering keyed in digits corresponding to local digits of a telephone number** (Figure 1, reference 10), and **storage memory for storing signals representing programmed digits** (Figure 1A, reference 15). In terms of a processor, as in claim 1, Waldman discloses the embodiment wherein “the invention can be readily executed by the use of a suitable microprocessor chip...and support hardware suitably programmed with software” (Column 5, Lines 50-55). Also disclosed is a module used to **retrieve from said storage signals representing programmed digits** (Figure 2B, Reference 18,19), a module to **combine said keyed digits with said programmed digits** (Figure 2B, Reference 14B), a module to **compare said keyed in digits with a set of special number sequences** (Figure 2, References 21, 39, 38), and a module for transmitting signals **corresponding to a telephone number based on results of said comparison of said keyed in digits with said special number sequences** (Figure 2B, Reference 20).

20. Regarding Claim 12, Waldman discloses an **area code selection device for selection of programmed digits corresponding to an area code of said telephone number** Column 3,

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Lines 15-20; Col. 17, lines 57-68). As stated in the rejection of claim 1, Waldman further describes a **processor programmed to retrieve said storage and combine said programmed digits with said keyed in digits and transmit a signal corresponding to a combined telephone number that includes said keyed in digits and said programmed digits** as described in Column 5, Lines 51-57 and diagrammed in Figure 2, references 22, 15, 18, 19.

21. Regarding Claims 15 and 16, Waldman specifies “a keypad may have a separate key or utilize any digit key together with a hold down feature to initiate an automatic dial out of any given programmed digits” (Column 17, Lines 57-68) corresponding to an **area code selection device that includes at least two push buttons for selection between two sets of programmed digits**).

22. Regarding Claim 17, Waldman provides an alternative embodiment wherein a “Voice Recognition” **real-time input device** acts to perform the function of the **area code selection device** (Column 18, Lines 54-62).

23. Regarding Claim 19, Waldman discloses claims and specifications wherein the telephone **is a wireless telephone** (Column 22, Lines 7-10 “Cellular” and “Mobile”).

24. Claim 13 is rejected under 35 U.S.C. 102(e) as being anticipated by Gabara (US Patent 6,292,557). In Figures 1 and 3 and subsequent areas of the specification, Gabara discloses an invention which receives **electrical signals corresponding to digits keyed in by a user** (Figure 1, Reference 20), compares the digits (Column 6, lines 28-32) via a **processor** (Column 3, Line 52) **to digits from a list of special number sequences** (Figure 1, Reference 24), and generates **signals corresponding to sequences of digits conditionally selected from a composite of**

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digits keyed in by user and preprogrammed area code digits (Figure 3, Reference 305 and remaining flowchart chain).

Claim Rejections - 35 USC § 103

25. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

26. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gabara in view of Yamartino (US Patent 6,345,095). Gabara discloses all of which was specified in claim 13, but does not disclose **the step of inputting the geographical location of the telephone for selection of preprogrammed area code digits**. Yamartino discloses a telephone number processing apparatus which accesses valid area codes based on calling party location information (Column 11, lines 35-44). It would have been obvious to one skilled in the art at the time of the invention to apply calling party location information as taught by Yamartino to the method taught by Gabara for the purpose of providing a selection menu of preprogrammed area code digits of a geographical location in order to reduce errors and digits dialed during telephone call initiation.

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27. Claims 4, 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Waldman in view of Singh (US Patent 6,157,379).

28. Regarding Claim 4 and 8, Waldman specifies that the embodiments and methods of the invention described are “contemplated to be used in and incorporated as part of stand alone Dialing Key Pads of all types for use with and to be incorporated into various telephone gear whether it be Cellular phones, Mobile phones, Key phones, Fax equipment” (in Column 22, Lines 1-21). Waldman also discloses all of which was claimed in claims 1, 2, and 7. Waldman does not explicitly describe the use of a **virtual keypad**. Singh discloses a multi-mode communication device, which uses a **virtual keypad** to place phone calls (Figure 1, section 26 and subsequent text in the specification). Singh also describes the necessary **circuitry for selection** and display of touchscreen elements (Column 4, Lines 18-25). It would have been obvious to one skilled in the art at the time of the invention to apply a **virtual keypad and subsequent display circuitry** as taught by Singh to the apparatus disclosed by Waldman for the purpose of providing a **real time input device** that can be used for additional functions.

29. Regarding claims 9 and 10, Singh further discloses a virtual keypad (Fig. 1, section 26) and circuitry for selection and display of said virtual keypad (Col. 4, Lines 18-25).

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Conclusion

30. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Theis (U.S. Patent 6,201,864) discloses an automatic area code detector/dialer.

McIntosh (U.S. Patent 6,169,799) discloses a similar automatic area code dialing apparatus and method.

Hatamura (U.S. Patent 5,894,507) discloses a telephone with function for adding and removing regional numbers from telephone numbers to be dialed.

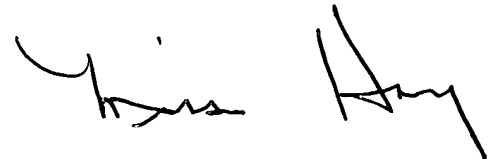
Harris et al (U.S. Patent 6,009,336) discloses a virtual keypad with multiple list options.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin D Auchter whose telephone number is 703-305-8635. The examiner can normally be reached on 8:00AM-5:00pm M-F Eastern Standard Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forester W Isen can be reached on 703-305-4386. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

BDA



MINSUN OH HARVEY
PRIMARY EXAMINER